

Patent - EVU-02-PUSA

REMARKS**Response to the examiner's consideration of affidavits filed June 19, 2003¹**

The examiner has indicated in the Office Action that the affidavits filed on June 19, 2003 were ineffective to overcome the *Shi* reference (U.S. Pat. No., 5,875,296, filed January 28, 1997). Those affidavits were: 1) the affidavit of Thomas C. Amon, dated August 6, 2002 (the Amon 2002 affidavit); and 2) the affidavit of Ronny Haraldsvik, dated September 4, 2002 (the 2002 Haraldsvik affidavit). Applicant respectfully disagrees with the examiner for the reasons stated herein. Applicant also has submitted herewith another affidavit of Thomas C. Amon, dated December 13, 2004 (the Amon 2004 affidavit).

1.a. The Amon 2002 affidavit

The examiner stated that paragraph 7 of the Amon 2002 affidavit does not show that the steps discussed were actually demonstrated, and does not show that a computer program was actually run. The examiner further stated that the "demonstration could consist of a simple explanation of how the invention is intended to work."

In response, Applicant submits that an actual demonstration did in fact occur. If there was any ambiguity in paragraph 7 of the Amon 2002 affidavit (which Applicant believes there was not), such ambiguity is now eliminated based on the Amon 2004 affidavit - specifically at least paragraphs 4a, 4b, 7, and 8.

1.b. Haraldsvik 2002 affidavit

The examiner stated that the Haraldsvik 2002 affidavit "does not clear up the ambiguous statements made in [the Amon 2002] affidavit, and also does not clearly show reduction to practice of the claimed invention."

Regarding the alleged ambiguities in the Amon 2002 affidavit, Applicant has addressed that above.

Regarding the Haraldsvik 2002 affidavit not showing an actual reduction to practice, Applicant submits that the Haraldsvik 2002 affidavit is not required nor intended to independently show actual reduction to practice, but instead is presented as *corroborating evidence* of the events set forth in the Amon 2002 affidavit. As set forth in *Cooper v. Goldfarb*, 154 F.3d 1321, 1330; (Fed. Cir. 1998) (internal cites omitted):

In order to establish an actual reduction to practice, an inventor's testimony must be corroborated by independent evidence. However, a "rule of reason" analysis is applied to determine whether an inventor's testimony regarding reduction to practice has been sufficiently corroborated. The rule requires an evaluation of all pertinent evidence when determining the credibility of an inventor's testimony. In order to corroborate a reduction to practice, it is not necessary to produce an actual over-the-shoulder observer. Rather, sufficient circumstantial evidence of an independent nature can satisfy the corroboration requirement. Furthermore, an actual reduction to practice does not require corroboration for every factual issue contested by the parties.

¹ The examiner referred to the affidavits as having been filed on June 19, 2003, but Applicant believes the affidavits were filed on June 16, 2003.

Patent - EVU-02-PUSA

In the present case, the Haraldsvik 2002 affidavit in fact sets forth unequivocal "over-the-shoulder" corroborating evidence that a demonstration occurred, and that a non-disclosure agreement was signed prior to the demonstration. This third-party testimony, in combination with a copy of the actual non-disclosure agreement, far exceeds the legal requirement of corroborating evidence as stated in *Cooper*.

1.c. Original Exhibits or photocopies thereof

The examiner stated that no original exhibits were submitted to establish reduction to practice. First, Applicant again submits that such documents are not required to show reduction to practice, but may instead be used to *corroborate* reduction to practice. The examiner recognizes that original exhibits or photocopies are not required if their absence is satisfactorily explained (37 C.F.R. 1.131(b)). Applicant explained why the exhibits were not available, but the examiner rejected the explanation as being unsatisfactory. Applicant respectfully disagrees with the examiner for the reasons stated herein. Applicant also has submitted herewith the Amon 2004 affidavit.

1.c.i. The non-disclosure agreement

Applicant submitted the non-disclosure agreement as *corroborating* evidence of reduction to practice. Both the Amon 2002 affidavit and the Haraldsvik 2002 affidavit refer to the non-disclosure agreement, and the Amon 2002 affidavit expressly states that the copy provided to the Patent Office was in fact the agreement referred to. Mr. Amon again has verified this in the Amon 2004 affidavit - specifically paragraph 6 thereof. Whether it was signed by Mr. Amon or not does not change the facts that it existed and that it has been authenticated by Mr. Amon and corroborated by Mr. Haraldsvik. Likewise, whether it refers to the actual invention or not does not change the facts that it existed and that it has been authenticated by Mr. Amon and corroborated by Mr. Haraldsvik. As such, the authenticated and corroborated copy of the non-disclosure agreement *corroborates* the testimony of Mr. Amon and Mr. Haraldsvik.

1.c.ii. The computer program and the magazine with notes

Regarding the original computer code, most computer programmers would understand that code constantly changes. Therefore, not only is it understandable that the original code from five years earlier did not exist, but it should be expected. The examiner suggests that Applicant should be able to produce a copy of the code or pseudo-code "at least as they existed prior to the filing date of the Shi reference". The examiner gives no reason why Applicant should be able to do this, but merely states that Applicant should be able to. However, the realities of computer programming, especially during the time frame in question as compared to today, were that it was very common not to retain previous versions of working code. The original code simply does not exist, and cannot be provided. A further explanation of why the original code does not exist is set forth in paragraph 5 of the Amon 2004 affidavit. Applicant submits that this explanation is more than satisfactory as required by Rule 131(b).

The examiner also states that "The fact that the *invention* changed since the demonstration of the original code is not a sufficient reason for failing to supply this evidence" (emphasis added), and that "the fact that the code changed since the original code actually clouds the issue of how much of the invention as filed on August 11, 1997 was actually reduced to practice as of September 5, 1996". Applicant's response is that Applicant did not state or argue that the *invention* changed. Applicant stated only that the code (embodying the invention)

Patent - EVU-02-PUSA

changed. Additionally, the fact that the code changed has no effect whatsoever on what was actually demonstrated on September 5, 1996, as stated in the Amon 2002 and 2004 affidavits and in the Haraldsvik 2002 affidavit. Whether the code changed, or did not change, those Amon and Haraldsvik affidavits clearly set forth what was in fact demonstrated on September 5, 1996.

Next, regarding the magazine with notes (which Mr. Amon reviewed in June, 1996), Applicant has been unable to locate it. However, that does not mean that it did not exist, or that the Amon affidavits should be rejected. There is other overwhelming evidence of reduction to practice from Mr. Amon, as well as the corroborating evidence including the affidavit of a third party, Mr. Haraldsvik, and a copy of the non-disclosure agreement. So even ignoring the magazine article and notes for the sake of argument, that would not change the fact that the demonstration to Mr. Haraldsvik occurred on September 5, 1996 (as evidenced by the Amon 2002 affidavit, the Amon 2004 affidavit, and the Haraldsvik 2002 affidavit), before the January 28, 1997 § 102(e) date of *Shi*.

1.d. Review of all of the evidence

The examiner stated that the 2002 affidavits combined with the non-disclosure agreement do not establish reduction to practice of the invention as claimed. The examiner stated that all of the independent claims recite "delivering information across a computer network", and require a "provider-selected message", and that Claims 2-4, 8, 10, and 11 describe a "server". The examiner stated that the 2002 affidavits fail to mention a demonstration of a computer network or of a provider-selected message.

Regarding the provider-selected message, Applicant respectfully disagrees with the examiner. The Amon 2002 affidavit, specifically paragraph 7, clearly explains that an "HTML advertisement" that appeared on the screen was in response to the user's request for an HTML page "other than that of the advertisement". The "HTML advertisement" therefore was not selected by the user, but on the contrary was selected by the provider. This is reiterated in paragraph 9 of the Amon 2004 affidavit.

Regarding the demonstration over a computer network, and/or using a server, Applicant respectfully disagrees with the examiner's strict requirement that the invention had to be tested over a computer network and/or server in order to establish a reduction to practice. Rather, the legal requirement is only that the demonstration showed that the invention was "suitable for its intended purpose". *Scott v. Finney*, 34 F.3d 1058, 1061 (and 1062-1063) (Fed. Cir. 1994). "Reduction to practice does not require 'that the invention, when tested, be in a commercially satisfactory stage of development'." *Scott*, 34 F.3d at 1061-1062. The Federal Circuit in *Scott* further explained that "When reviewing the sufficiency of evidence of reduction to practice, this court applies a reasonableness standard" (*Scott*, 34 F.3d at 1062), and that reduction to practice "does not require actual use, but only a reasonable showing that the invention will work to overcome the problem it addresses." *Scott*, 34 F.3d at 1063.

In *Scott*, the court found that the invention (a penile implant) was reduced to practice even though it was not tested under actual use conditions or under conditions that closely simulated actual use conditions. The court stated that "prior art prosthetic devices had fully tested the workability of most features of [the] invention. [...] Only the hydraulics of a fully self-contained internal prosthesis remained to be tested for workability. [The inventor] adequately showed the workability of these features." *Scott*, 34 F.3d at 1063. The Federal Circuit explained that in that case "of a solution to a relatively simple problem, the Board

Patent - EVU-02-PUSA

required more testing than necessary to show that the device would work for its intended purpose." *Scott*, 34 F.3d at 1063.

In the present case, the affidavits are sufficient to show that the invention was suitable for its intended purpose. Prior art computer networks and client-server environments were well-known, and so even if the invention requires a network, that aspect of the invention would not have to be tested to evidence a reduction to practice. A simulation would be adequate to show that the invention was suitable for its intended purpose. In fact, in *Taskett v. Denlinger*, 344 F.3d 1337 (Fed. Cir. 2003), the court, citing *Scott*, found that a method was reduced to practice based on a computer simulation that used a "dummy checking account". The court in *Taskett* also cited *Williams v. Administrator of NASA*, 463 F.2d 1391 (CCPA 1972), which found that lab testing for an invention intended for attitude control of a yet-to-be-launched communications satellite was sufficient to show reduction to practice. *Taskett*, 344 F.3d at 1341-1342. The court in *Taskett* reiterated that reduction to practice does not require a viable commercial embodiment. *Taskett*, 344 F.3d at 1342.

Certainly implementation of the invention in this case over a computer network was a "relatively simple problem" as compared to controlling a satellite, and since an invention involving the control of a satellite was found to be reduced to practice by a simulation, the present invention should likewise be found to have been reduced to practice. Further, the code in the present case was written in HTML and JAVA script, and was demonstrated using both Netscape and Windows browser environments, without any modifications to the browsers (Amon 2004 affidavit, paragraph 7), and the code was tested on Mr. Amon's internet hosting site (Amon 2004 affidavit, paragraph 8). Applicant therefore submits that even if the claims require a network and/or a server environment, the demonstration clearly evidenced that the invention was "suitable for its intended purpose" as required by *Scott*.

Response to examiner's § 102(e) rejection over Shi

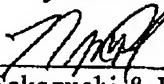
For the reasons set forth above, Applicant submits that the Amon 2002 affidavit and the Haraldsvik 2002 affidavit, in combination with the Amon 2004 affidavit, establish that *Shi* is not prior art to the claimed invention, because the claimed invention was reduced to practice prior to the § 102(e) reference date of *Shi*.

Conclusion

Applicant respectfully submits that *Shi* is not prior art to the claimed invention, and that the rejections have thus been overcome. Applicant therefore requests the examiner issue a notice of allowance. If the examiner has any questions, the examiner is invited to contact Applicant's undersigned representative.

Respectfully submitted,

Dated: December 13, 2004


Cohen Sakaguchi & English LLP
Neal M. Cohen (Reg. No. 41,683)

**This Page is Inserted by IFW Indexing and Scanning
Operations and is not part of the Official Record**

BEST AVAILABLE IMAGES

Defective images within this document are accurate representations of the original documents submitted by the applicant.

Defects in the images include but are not limited to the items checked:

- BLACK BORDERS**
- IMAGE CUT OFF AT TOP, BOTTOM OR SIDES**
- FADED TEXT OR DRAWING**
- BLURRED OR ILLEGIBLE TEXT OR DRAWING**
- SKEWED/SLANTED IMAGES**
- COLOR OR BLACK AND WHITE PHOTOGRAPHS**
- GRAY SCALE DOCUMENTS**
- LINES OR MARKS ON ORIGINAL DOCUMENT**
- REFERENCE(S) OR EXHIBIT(S) SUBMITTED ARE POOR QUALITY**
- OTHER: _____**

IMAGES ARE BEST AVAILABLE COPY.

As rescanning these documents will not correct the image problems checked, please do not report these problems to the IFW Image Problem Mailbox.